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EXAMINER

ZEE, EDWARD

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,484	<b>Applicant(s)</b> MOULANA ET AL.	
	<b>Examiner</b> EDWARD ZEE	<b>Art Unit</b> 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 12-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to the amendments filed on 02/12/10. Claims 1, 10, 18, 21, 22, 23 and 24 have been amended; Claims 1-8, 10 and 12-24 are pending and have been considered below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/12/10 has been entered.

#### ***Claim Objections***

**Claims 1-8, 10 and 12-24** are objected to because of the following informalities: Based upon the arguments submitted by Applicant, it appears that the newly introduced feature to the independent claims "*searching, from the optical medium*" was made in an effort to distinguish from a search being performed by software which resides in a computer (please see pages 7-8 of the remarks filed on 02/12/10).

However, Examiner notes that the particular sections of the specification cited by Applicant as support for the new amendments to the independent claims merely describe storing the protection program on the optical medium itself, and does not appear to disclose how the claimed "searching" is actually accomplished from the optical medium itself. Nor would one of ordinary skill in the art readily understand how to accomplish the "searching" directly from the

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program code stored on the optical medium without somehow loading the program code into the computer which it is executing on.

Therefore, the Applicant is kindly requested to clarify these issues. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-8, 10 and 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inokuchi et al. (2004/0133523) in view of Miles (2005/0223240).**

**Claim 1:** Inokuchi et al. discloses a method of preventing use of an unauthorized copy of a software program residing on an optical medium, the method comprising:

a. providing a protection program(*ie. determining program*), the protection program residing with the software program(*ie. software*), the protection program:

i. searching for a file on the optical medium prior to determining a media type of the optical medium, the file containing the software program(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

ii. determining the media type of the optical medium containing the software program(*ie. determines whether the loaded disc is an original or a copied disc*) [page 8, paragraph 0155];

iii. and inhibiting execution of the software program stored on the optical medium if: the file is missing on the optical medium, or the optical medium has media type that indicates that the optical medium is copied(*ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted*) [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described “determining program” is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed(*...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program determines whether the loaded disc is an original or a copy...*) [page 8, paragraph 0154], Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded(*...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first access the disc...this may be done automatically using an autorun function...*) [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles,

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in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

**Claims 2 and 3:** Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that the step of inhibiting the execution of the software program comprises preventing execution of selected features of the software program by determining a set of features of the software program to execute(*ie. selectively restrict only encrypted data, etc.*) [page 8, paragraph 0149].

**Claim 4:** Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that the step of inhibiting the execution of the software program comprises preventing execution of the software program(*ie. operation is cancelled*) [page 8, paragraph 0149].

**Claim 5:** Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that the step of determining the media type comprises inserting the optical medium in a drive of a computer and reviewing a medium-type code field contained in a mode parameter header of the optical medium(*ie. ATIP information such as writing characteristics, capacity, disc type, etc.*) [page 6, paragraph 0124].

**Claim 6:** Inokuchi et al. and Miles disclose the method as in claim 5, and Inokuchi et al. further discloses that the drive is a CD-R/W drive [page 2, paragraph 0029].

**Claim 7:** Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that a media type indicates that the optical medium is copied is one of a write-once media type and an erasable/rewriteable media type [page 6, paragraph 0124].

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**Claim 8:** Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses the step of executing the software program stored on the optical medium if the step of determining determines the optical medium to be an optical read-only medium [page 7, paragraph 0145].

**Claim 10:** Inokuchi et al. discloses a method of authenticating an original optical medium, the method comprising:

a. accessing the optical medium in a compact disk-read/write (CD-R/W) drive coupled to a computer [page 2, paragraph 0029];

b. and identifying a protection program(*ie. determining program*) on an optical medium, the protection program:

i. searching for a file on the optical medium prior to checking a media type of the optical medium, the file containing a software program to be authenticated(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

ii. and checking the media type of the optical medium once the file has been located(*ie. determines whether the loaded disc is an original or a copied disc*) [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described “determining program” is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed(*...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program*

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*determines whether the loaded disc is an original or a copy...*) [page 8, paragraph 0154],

Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded(*...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first access the disc...this may be done automatically using an autorun function...*) [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles, in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

**Claim 12:** Inokuchi et al. and Miles disclose the method as in claim 10 above, and Inokuchi et al. further discloses that the step of checking a media type comprises reviewing a medium-type code field contained in a mode parameter header of the optical medium(*ie. TOC*) [page 6, paragraph 0120].

**Claims 13-15:** Inokuchi et al. and Miles disclose the method as in claim 10 above, and Inokuchi et al. further discloses:

a. the step of checking the media type comprises verifying that the optical medium has a read-only media type and that it is indicative that the optical medium is an original version [page 7, paragraph 0145];



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b. the step of executing a software program stored on the optical medium if the optical medium has a read-only media type [page 7, paragraph 0145].

**Claim 16:** Inokuchi et al. and Miles disclose the method as in claim 10 above, and Inokuchi et al. further discloses that the step of checking the media type comprises identifying if the media type is one of a write-once media type and an erasable/rewritable media type [page 6, paragraph 0124].

**Claim 17:** Inokuchi et al. and Miles disclose the method as in claim 16 above, and Inokuchi et al. further discloses the step of inhibiting execution of a software program stored on the optical medium if the step of checking identifies that the media type is one of a write-once media type and an erasable/rewritable optical media type [page 7, paragraph 0132].

**Claim 18:** Inokuchi et al. discloses a method of preventing execution of an unauthorized copy of a software program stored on an optical medium, the method comprising:

a. identifying a protection program(*ie. determining program*) residing on the optical medium with the software program(*ie. software*), the protection program:

i. searching for a file on the optical medium containing the software program prior to determining a media type of the optical medium, the file containing the software program(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

ii. determining the media type of the optical medium(*ie. determines whether the loaded disc is an original or a copied disc*) [page 8, paragraph 0155];

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iii. and executing the software program stored on the optical medium if: the file is included on the optical medium, and the optical medium has a media type that indicates that the optical medium is an original version(*ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted*) [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described “determining program” is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed(*...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program determines whether the loaded disc is an original or a copy...*) [page 8, paragraph 0154], Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded(*...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first access the disc...this may be done automatically using an autorun function...*) [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles, in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

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**Claim 19:** Inokuchi et al. and Miles disclose the method as in claim 18 above, and Inokuchi et al. further discloses that a read-only media type indicates that the optical medium is an original version [page 7, paragraph 0145].

**Claim 20:** Inokuchi et al. and Miles disclose the method as in claim 18 above, and Inokuchi et al. further discloses the step of inhibiting execution of the instructions if the optical medium does not have a read-only media type [page 7, paragraph 0132].

**Claims 21-23:** The instant claims, as noted by Applicant, recite similar subject matter as claims 1, 10 and 18 above, and thus are rejected under similar rationale.

**Claim 24:** Inokuchi et al. discloses an electronic device comprising:

- a. a memory for storing computer program instructions [page 2, paragraph 0029];
- b. a processor for executing the stored computer program instructions [page 2, paragraph 0029];
- c. and a compact disk-read/write (CD-R/W) drive for receiving an optical medium containing a software program(*ie. software*) and a protection program(*ie. determining program*), the protection program including instructions for:
  - i. searching for a file on the optical medium containing the software program prior to determining a media type of the optical medium, the file containing the software program(*ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted*) [page 8, paragraph 0155];

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ii. determining the media type of the optical medium(*ie. determines whether the loaded disc is an original or a copied disc*) and inhibiting execution of the software program stored on the optical medium if the file is missing on the optical medium or the optical medium has media type that indicates that the optical medium is copied(*ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted*) [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described “determining program” is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed(*...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program determines whether the loaded disc is an original or a copy...*) [page 8, paragraph 0154], Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded(*...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first access the disc...this may be done automatically using an autorun function...*) [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles,

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in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 10, 18 and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD ZEE whose telephone number is (571)270-1686. The examiner can normally be reached on Monday through Thursday 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edward Zee/  
Examiner, Art Unit 2435